

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Hearing:  
May 31, 2000  
BAC

10/24/00

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Johnson & Johnson

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Serial No. 75/010,166

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Norm D. St. Landau of Tucker Flyer, P.C. and Richard F. Biribauer for Johnson & Johnson.

Jennifer Stiver Chicoski, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

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Before Hanak, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On October 20, 1995, Johnson & Johnson filed an application to register the mark shown below

for "first aid kits." The application includes the following description of the mark:

"The mark consists of a Red Greek Cross applied to a blue colored container for

first aid kits. The dotted outline of the container is intended to show the position of the mark and is not a part of the mark. The drawing is lined for the colors red and blue, and color is claimed as a feature of the mark."

Applicant claims the following first use dates: (i) its "Red Greek Cross mark" in connection with medical and surgical plasters as early as 1887; (ii) its "Red Greek Cross mark" in connection with first aid kits in interstate commerce as early as 1898; and (iii) its current mark in connection with first aid kits both anywhere and in interstate commerce as early as 1985.

Also, applicant claims ownership of Registration Nos. 54,308<sup>1</sup>; 1,870,955<sup>2</sup>; 1,888,143<sup>3</sup> and 1,889,576<sup>4</sup>.

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<sup>1</sup> Registration No. 54,308 issued June 26, 1906, re-renewed, for the following mark:

for "medical and surgical plasters." The drawing is lined for the color red. The claimed date of first use is 1887.

<sup>2</sup> Registration No. 1,870,955, issued January 3, 1995, for the word mark RED CROSS (in typed form) for "cotton for personal use" and "sterile cotton for medical use." The claimed date of first use is 1898.

<sup>3</sup> Registration No. 1,888,143, issued April 11, 1995, for the following mark:

for "cotton for cosmetic use." The drawing is lined for the color red. The claimed date of first use is 1898.

<sup>4</sup> Registration No. 1,889,576, issued April 18, 1995, for the "red cross" design mark shown in footnote 3 for "first aid kits,

The Examining Attorney initially refused registration on two grounds: (1) that the mark falsely suggests a connection with the American Natitonal Red Cross under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a); and (2) that the mark consists of or comprises a mark the use of which is proscibed by statute, namely 18 U.S.C. §706. The Examining Attorney withdrew the refusal to register under Section 2(a) of the Trademark Act, and made final the refusal to register under 18 U.S.C. §706.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs<sup>5</sup>, and both were present at an oral hearing before this Board.

First, we must address the Examining Attorney's basis for the refusal to register. As explained in the Trademark Manual of Examining Procedure at TMEP §1205.01, various federal statutes prohibit or restrict the use of certain, words, names, marks, insignia, seals, etc. In fact, TMEP

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adhesive bandages, topical preparations for medical and therapeutic use, medical adhesive tape, gauze, sterile cotton for medical purposes, and wound dressings." The drawing is lined for the color red. The claimed date of first use is 1898.

<sup>5</sup> Applicant attached to its brief on the case several exhibits, specifically, copies of some court decisions, copies of legislative history materials from 1942 Congressional hearings, and applicant's 1904 price list. The Examining Attorney objected to all of these exhibits as untimely filed under Trademark Rule 2.142(d). The Board can consider judicial decisions and legislative history even if not introduced into the record by either side. The Examining Attorney's objection is not well taken except as to applicant's 1904 price list.

§1205.01 includes as one example use of the Greek red cross other than by the American National Red Cross is proscribed by 18 U.S.C. §706. In that same section of the Manual there is further explanation, as follows:

Usually the statute will define the appropriate use of a designation and will prescribe criminal penalties or civil remedies for improper use. However, the statutes themselves do not provide the basis for refusal of trademark registration.

The Manual goes on to explain various possible refusals to register under the **Trademark Act**, such as, applicant's use of the mark would be unlawful under the referenced statute (Sections 1 and 45 of the **Trademark Act**, 15 U.S.C. §§1051 and 1127), or Section 2(a) falsely suggesting a connection with the institution or person specified in the statute, or Section 2(b) matter comprising a flag, coat of arms, etc.

Based on the arguments and record before us (particularly the Examining Attorney's argument that applicant's current mark is not included in the "grandfather" provision of 18 U.S.C. §706), we construe the Examining Attorney's refusal to register to be one based on Sections 1 and 45 of the **Trademark Act**, i.e., that applicant's use of this mark (the Greek red cross on a blue background) is unlawful under 18 U.S.C. §706.

The protecting statute, 18 U.S.C. §706 "Red Cross," reads, in relevant part, as follows:

Whoever, whether a corporation, association or person, other than the American National Red Cross and its duly authorized employees and agents and the sanitary and hospital authorities of the armed forces of the United States, uses the emblem of the Greek red cross on a white ground, or any sign or insignia made or colored in imitation thereof or the words "Red Cross" or "Geneva Cross" or any combination of these words—

Shall be fined under this title or imprisoned not more than six months, or both.

This section shall not make unlawful the use of any such emblem, sign, insignia or words which was lawful on the date of enactment of this title.

Upon a reading of 18 U.S.C. §706, we find that the statute is clear on its face, and that applicant's current applied-for mark (the Greek red cross on a blue background) is simply not a "Greek red cross on a white ground, or any sign or insignia made or colored in imitation thereof" within the plain meaning of the statute. Nor do we find any basis to interpret "colored in imitation thereof" to include a blue background. That is, this statute does not prohibit applicant's use of the applied-for mark.

Further, in the case of *Johnson & Johnson v. Jack Frost Laboratories Inc.*, \_\_ F.2d \_\_, 14 USPQ2d 1076 (Fed.

Cir. 1990)(listed as "unpublished" <sup>6</sup>), the Court noted the following:

"This is not to say Jack Frost's marks without a red cross might not be registrable. Indeed, the Opposer [Johnson & Johnson] conceded it 'would not object to the registration of [applicant's] marks if the applications disclaim any right to use the Greek cross portion *in red on a white background*, or a colorable imitation thereof.' Appellant's Brief, *Johnson & Johnson*, No. 89-1291, at 15 (Fed. Cir. filed October 23, 1989) (emphasis added)."

See also, *In re Health Maintenance Organizations, Inc.*, 188 USPQ 473 (TTAB 1975).

It is important to note that inasmuch as 18 U.S.C. §706 is a criminal statute, it must be strictly construed. See *United States ex rel. Federal Bureau of Investigation v. Societe Anonyme Francaise M. Bril and Co.*, \_\_ F.Supp. \_\_, 187 USPQ 685, 688 (DCDC 1975).

The Board cases regarding unlawful use require a high standard be met, i.e., clear and convincing evidence that use would constitute a material violation of the applicable law. In fact, the Board has stated in the past that we will normally hold use of a mark in commerce unlawful only

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<sup>6</sup> The Board does not normally refer to "unpublished" cases, but in this specific situation, the Court case involves a quotation from the brief of the very party now before us.

when the issue of lawfulness has previously been determined by a court or governmental agency having competent jurisdiction under the statute involved, or where there has been a per se violation of a material portion of the statute regulating the sale of a party's goods. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1271 (TTAB 1992); *Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d 2045 (TTAB 1988); and *Satinine Societa in Nome Collettivo di S.A. e M. Usellini v. P.A.B. Produits et Appareils de Beaute*, 209 USPQ 958 (TTAB 1981). Here a criminal statute is involved, which makes it even more imperative that any violation by applicant be first determined by a court having competent jurisdiction under the statute.

From the record before us, we cannot say that applicant's use of its applied-for mark is unlawful under 18 U.S.C. §706, as would constitute a basis for refusal under Sections 1 and 45 of the **Trademark Act**.

Decision: The refusal to register is reversed.

E. W. Hanak

B. A. Chapman

H. R. Wendel  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board